

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cory O. Nykoluk et al. : Group Art Unit: 3781
Serial Number: 10/688,477 : Examiner: Tri M. Mai
Filed: October 17, 2003 :
For: PIVOTAL HANDLE FOR :
TOWABLE BAGGAGE :

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief-Patents
Hon. Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Examiner's Answer dated August 22, 2008 Appellants submit the present Reply Brief.

I. Status of Claims

Claims 1-29, 36, 37, 51 and 52 are cancelled. Claims 30-35, 38-50 and 53-56 remain in the application. Claim 31 stands objected to, and claims 53-56 have been allowed. Claims 30, 32-35, and 38-50 are finally rejected and are appealed.

II. Grounds of Rejection to be Reviewed on Appeal

- A. Whether claims 30, 34, 35 and 38-47 are unpatentable under 35 U.S.C. § 103(a) over Sadow in view of Liang and further in view of Sparks.
- B. Whether claims 32 and 33 are unpatentable under 35 U.S.C. § 103(a) over Sadow in view of Liang and Sparks and further in view of Browning.
- C. Whether claims 48, 49 and 50 are unpatentable under 35 U.S.C. § 103(a) over Sadow in view of Liang and Sparks, and further in view of Miyoshi.
- D. Whether claims 30, 34, 35, 37 and 42-47 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Williams et al.

III. Argument

Appellants position with respect to the cited art is generally maintained. Appellants, however, would like to respond to certain positions taken by the Examiner in the Answer.

A. The § 102 Rejection over Williams

As a matter of claim interpretation, the Examiner notes in the Answer on pages 3 and 7 that the term “fixedly mounted” as it appears in independent claim 30 is broad and does not require the two portions to be immovably connected. Appellants submit that that this proposition is self contradictory. It is believed that two portions that are movably connected would not be “fixed” and the Examiner’s position is contrary to the plain meaning of the words used and is a facially unreasonable interpretation of the claim language. As Appellants have argued, Williams et al. do not disclose “a connector fixedly mounted to said distal end” as independent claim 30 recites.

Regarding the Williams et al. disclosure, the Examiner continues to take little interest in what Williams et al. actually describes and teaches, and instead insists upon his own independent assessment of the Williams et al. Figures and what they allegedly depict. The Examiner’s conclusions, however, contradict the Williams et al. disclosure and are submitted to be unreasonable.

The Examiner submits that there is no structural difference between the claimed connector and portion (50a) in Williams. Appellants submit that there is. Independent claim 30 recites that the connector is “fixedly mounted” to the distal end of the arm portion. The Examiner admits on page 7 of his Answer that the pole sections (50a), (50b) and (50c) of Williams et al. are independently rotatable relative to one another, so even if the portion (50a) was considered to be the connector as the Examiner wants it to be, independent claim 30 is still distinguishable and is not anticipated by Williams et al.

Appellants submit, though, that the portion (50a) cannot reasonably be considered the recited connector at all because Williams et al. explicitly identifies it as a section of a larger telescoping pole (50). Williams et al. identify the telescoping pole (50) and its sections (50a), (50b) and (50c) as one structure, and the handle (20) as another structure attached to the pole at

the section (50a). As Appellants have noted, the Williams et al. disclosure is silent regarding how the handle is attached to the pole, but conspicuously absent is any disclosure, or even a suggestion, of a connector. The Office is not free to fill this gap in teaching of the Williams et al. disclosure by re-designating the pole section (50a) as a “connector” on the ground that there is “no structural difference” as the Examiner’s Answer states.

As Appellants have acknowledged, the Office may apply the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification. Certainly, the ordinary usage of the words “connector” and “arm portion” in independent claim 30 does not suggest that these are one and the same structures. Further, the written description affords enlightenment that Appellants have not considered these to be one and the same structures. The Examiner, however, has done exactly that, and simultaneously considers the larger telescoping pole (50) disclosed by Williams to correspond to two different and separately recited elements of independent claim 30, namely both the arm portion via section (50b) of Williams et al. pole (50) and the connector via section (50a) of the Williams et al. pole (50). Appellants submit that the anticipation rejection over Williams et al. rests on an improper double counting of the Williams et al. pole (50) as satisfying more than one of the different recitations in independent claim 30, while conveniently ignoring that the Williams et al. disclosure is simply silent on material points of the subject matter claimed.

The Examiner attempts to justify the rejection by submitting that the pole section (50a) is structurally distinguished from the “major portion” of the pole comprising sections (50b) and (50c). Appellants simply see no basis for dissecting the pole sections (50a), (50b) and (50c) from one another in such a manner. Williams et al. does not make any such distinction between major and minor portions of the pole (50) or its pole sections (50a), (50b) and (50c). Neither does independent claim 30, and neither should the Examiner.

Unfortunately, the Examiner further appears to misconstrue the Appellants’ own specification in an attempt to justify the rejection. On page 7, the Examiner submits that the although the specification defines portion 54 as the connector, “the actual connection is that of

portion 52 which is connected to the arm and the stem of the handle.” The Examiner repeats the same error made with respect to the Williams et al. disclosure by rejecting what Appellants have actually described in favor of his own opinion of what one of the Figures depicts. In any event, the Examiner’s opinion is clearly incorrect. Item 52 cited by the Examiner in Figure 6 is a counterbore in the handle. It is believed that the Examiner intended to refer to the journal-pin or pivot pin 56 in Figure 6, but this would not help the examiner’s cause because the journal pin 56 is not a connector either. Appellants have identified one connector, shown as element 54 in Figure 6, and the Office is not free to disregard Appellants terminology either and re-designate the depicted components for the convenience of the Office in rejecting the claims.

The Examiner’s conclusion in the last couple lines of page 7 of the Answer that Appellants own definition does require the connector to be immovably connected is simply untrue. Appellants have not identified or defined any component as a “connector” other than the connector 54, which as Appellants describe in the specification is secured, for example, to the free end of the 38 of the telescoping section 30 by a pair of screws or rivets 78. Consequently, the connector 54 is, in the Examiner’s words, immovably connected in the example embodiment described and depicted in Figure 6 and as claimed in independent claim 30.

Appellants submit that the rejection over Williams et al. should be reversed for the reasons above, in addition to the reasons supplied in Appellants Brief of record.

B. The § 103 Rejections

Appellants position with respect to the § 103 Rejections is generally maintained. Appellants, however, wish to respond to certain positions taken by the Examiner in the Answer.

On page 8 of the Answer, the Examiner notes that for the Liang handle (72) to be mounted on the arm (56) there would obviously be a connector. Appellants disagree, and have noted that Liang describes a handle that is directly mounted to the arm such that a separate connector is obviated. The Examiner concedes that Liang does not teach that a connector is utilized.

Instead, the Examiner cites Sparks as disclosing a connector, and concludes that the Sparks connector would have been obvious to include in the Liang handle “to provide an

alternative for connecting the handle to the arm.” Appellants submit, however, that “providing an alternative” is not a reason to modify anything that provides a rational underpinning to support the conclusion of obviousness per *KSR*. The examiner appears to suggest that the handles of Liang and Sparks are interchangeable substitutes, but they are clearly not. Appellants have identified structural and functional aspects between the handle constructions of Liang and Sparks that would prevent them from fairly being considered “alternatives” that could simply be substituted for one another. Indeed, Appellants submit that the handle constructions of Liang and Sparks are simply incompatible on a number of levels.

Assuming, for the sake of argument only, that even if the handle constructions of Sadow, Liang and Sparks were deemed to be alternatives to one another, *KSR* still requires reasons to be articulated *why* it would have been obvious to combine aspects of them. *KSR* clearly stated that obviousness is not proven merely by establishing that individual elements were known in isolation, which is effectively all the Examiner has done in the instant rejection. The Examiner’s Answer, like the final rejections, is merely conclusory, and unsustainable, for failing to articulate *why* the invention would have been obvious and consequently failing to present a *prima facie* case of unpatentability of the claimed invention.

On page 8 of the Answer, the Examiner states that the “only structure being modified here is the connector that is used to connect the two parts.” This is not true. Because neither the Liang or Sadow handle constructions involve a connector, adding a connector such as the Sparks connector would certainly entail alterations of the handles of Liang or Sadow, as well as the Sparks connector itself, to implement it in the manner proposed in the Office Action.

It is not at all evident, and the Examiner has not explained, *why* it would have been obvious for one of ordinary skill in the art at the time of the invention to have started with the Sadow handle that does not pivot, replace it with the handle of Liang that does pivot, and then utilize a connector disclosed by Sparks that is designed to prevent the handle from pivoting. The end result would have been a handle that does not pivot, which was already provided in the Sadow handle without modification. Each of the handle constructions disclosed by Sadow, Liang and Sparks is designed for specific reasons and in light of different considerations, all of which the Examiner ignores.

On page 4 of the Examiner's Answer it is stated that it would have been obvious to provide a separate connector at taught by Sparks to provide a separate connector to enable one to install the handle properly. There is nothing improper, however, regarding the installations of the handle of Liang or Sadow that reasonably supports this view.

Browning is cited for disclosing a handle having a non-circular cross section. Browning does not cure the deficiencies of the other references, however, with respect to the subject matter of the independent claims. Also, on page 8 of the answer, the Examiner states that it would have been obvious to provide a non-circular cross section to provide "the desired cross section" for the handle. Absent a reason *why* this would have been desirable, however, this is not a basis for concluding that the presently claimed subject matter is obvious, nor is it a reason providing a rational underpinning of the conclusion of obviousness as mandated by *KSR*.

Similarly, Miyoshi is not believed to add anything to the teaching of Sadow, Liang and Sparks with respect to the subject matter claimed, and does not present a *prima facie* case of obviousness of the subject matter claimed.

Appellants submit that the § 103 rejections should be reversed for the reasons above, in addition to the reasons supplied in Appellants Brief of record.

IV. Related Proceeding Appendix

A Decision on Appeal was rendered August 4, 2008 in Appeal No. 2008-1778 involving U.S. Application Serial No. 10/875,394. The Decision is attached in the Appendix herewith. The Decision is not believed to affect the outcome of the present appeal, but is submitted for purposes of disclosure.

As of the date of the submission of this Reply Brief no decision has been rendered in any of the other related proceedings identified in Appellants' Appeal Brief.

V. Conclusion

For the foregoing reasons, reversal of the Final Rejection of the claims is respectfully requested.

Respectfully submitted,



Bruce T. Atkins, Registration No. 43,476
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070

Related Proceedings Appendix



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/8'5,394	06/23/2004	Cory O. Nykoluk	10759-00154	8485
7590	08/04/2008		EXAMINER	
Patrick W. Rasche			MAI, TRIM	
Armstrong Teasdale LLP			ART UNIT	PAPER NUMBER
Suite 2600			3781	
One Metropolitan Square				
St. Louis, MO 63102				
			MAIL DATE	DELIVERY MODE
			08/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CORY O. NYKOLUK

Appeal 2008-1778
Application 10/875,394
Technology Center 3700

Decided: August 4, 2008

Before TONI R. SCHEINER, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a towing member that is configured to be joined to a piece of baggage. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Background

“A typical towable piece of baggage generally includes a pair of wheels and an extendable towing member connected to the piece of baggage” (Spec. 2). The Specification comments that “the towing member of a prior art wheeled-backpack is typically supported by the rigid base of the backpack on which the wheels are mounted” (Spec. 5).

Statement of the Case

The Claims

Claims 27-49 are on appeal¹. We will focus on claims 27, 28, 34 and 39, which are representative and reads as follows:

27. A towing member configured to be joined to a piece of baggage having a base, the towing member comprising:
 - a handle;
 - a non-extendable portion configured to be fixedly attached to the base at a location interior to the piece of baggage; and
 - a curved arm slideably received within the non-extendable portion and movable relative to the non-extendable portion along a curved telescoping path between a retracted position and an extended position, the arm having a distal end with the handle proximate thereto, the handle being positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm is in the extended position, the arm having a curved portion that is retracted into the non-extendable portion when in the retracted position.

¹ We note that issues relating to the finality of a rejection are reviewable by way of petition under 37 CFR § 1.181, not by appeal to this Board. See, e.g., *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971).

28. The towing member of claim 27, wherein the arm has a proximal end slidably retained within the non-extendable portion, the arm being uniformly curved along a complete length thereof from the proximal end to the distal end.

34. The towing member of claim 27, further comprising a rigid base having a bottom portion and a pair of wheel wells on opposite ends thereof.

39. A towing member configured to be joined to a piece of baggage having a base, the towing member comprising:

a handle;

a non-extendable portion having an axial length and a curvature along the axial length; and

a curved arm slideably received within the non-extendable portion and movable relative to the non-extendable portion along a curved telescoping path between a retracted position and an extended position, the arm having a distal end with the handle proximate thereto, the handle being positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm is in the extended position, the arm having a curved portion that is retracted into the non-extendable portion when in the retracted position, the arm having a proximal end slidably retained within the non-extendable portion, the arm being uniformly curved along a complete length thereof from the proximal end to the distal end.

The prior art

The Examiner relies on the following prior art references to show unpatentability:

Nykoluk	US 6,942,077	Sep. 13, 2005
Mao	US 6,279,706	Aug. 28, 2001
Gold	US 5,779,248	Jul. 14, 1998
Miyoshi	US 5,908,093	Jun. 1, 1999

Raynor	US 3,549,164	Dec. 22, 1970
Godshaw	US 5,893,495	Apr. 13, 1999

The issues

The rejections as presented by the Examiner are as follows:

- A. Claims 27-49 stand rejected under the ground of nonstatutory obviousness-type double patenting over claims 1-15 of Nykoluk (Ans. 4).
- B. Claims 34 and 45 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite (Ans. 5).
- C. Claims 27-29, 31, 32, 34, 37-44, and 46-48 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gold (Ans. 5).
- D. Claim 33 stands rejected under 35 U.S.C. § 103(a) as being obvious over Gold and Miyoshi (Ans. 6).
- E. Claims 27, 32 and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Raynor (Ans. 6).
- F. Claims 27-29, 32-35, 37-40, 43, 44, 46, 48, and 49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Miyoshi (Ans. 6).
- G. Claim 36 and 47 stand rejected under 35 U.S.C. § 103(a) as being obvious over Miyoshi and Godshaw (Ans. 6).
- H. Claims 27-49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mao² (Ans. 7).

² Unlike every other rejection, the Examiner does not restate the Mao rejection, only arguing the rejection at page 7 of the Answer. Since Appellant fully addresses the Mao rejection, in the interests of complete analysis, we will also address the Mao rejection using the statement in the final rejection.

A. Obviousness-type double patenting over claims 1-15 of Nykoluk

Appellant argues that the “claims of the ’077 Patent may not be used as a template to compile a list of isolated features that may be combined in any possible combination to reject claims as obvious, without regard to the combinations actually claimed in the ’077 Patent” (App. Br. 9). Appellant contends that “claim 1 of the ’077 Patent recites at least six features which the presently pending claim 1 does not, and presently pending claim 27 recites at least six features which claim 1 of the ’077 Patent does not” (App. Br. 10). Appellant states that “[i]t is not believed that it would be considered obvious to one of ordinary skill in the art to make at least the 12 changes identified above to claim 1 of the ’077 Patent that would be necessary to arrive at the invention of present claim 27” (App. Br. 11).

The Examiner responds that

at least claim 14 of US 6,942,077 meets the claimed limitations with respect to the curved towing handle selectively extended upwardly and forwardly from the pack and retracted back toward the pack along an arcuate path curved away from the pack as set forth in claim 1, and a non-extendable portion as shown above. . . The examiner submits that claim 27 of the present application recites, “comprising” that does not exclude other structures into the claim. Thus, the present of other structures in the claim 14 of US 6,942,077.

(Ans. 7.)

In view of these conflicting positions, we frame the non-statutory obviousness type double patenting issue before us as follows:

Are claims 27-49 obvious over the teaching of claims 1-15 of Nykoluk?

Findings of Fact

1. Claim 14 of Nykoluk teaches “a towing handle” (Nykoluk, col. 10, l. 14).

2. Claim 14 of Nykoluk teaches a “non-extending portion of the telescoping member” of the towing handle (Nykoluk, col. 10, ll. 21-22).

3. Claim 14 of Nykoluk teaches “a curved, telescoping member, the telescoping member allowing the handle to be selectively extended upwardly and forwardly from the pack and retracted back toward the pack along an arcuate path curved away from the pack” (Nykoluk, col. 10, ll. 14-18).

Discussion of Obviousness-type double patenting over claims 1-15 of Nykoluk

We find that the relationship of claim 14 of Nykoluk to the instant claim 27 is that of anticipation. Claim 14 of Nykoluk teaches all of the elements necessary for the towing member of claim 27, including a handle (FF 1), a non-extendible portion that is attached to a piece of baggage (FF 2) and a curved telescoping arm which is not positioned over the bag when extended (FF 3).

The proper test for double patenting in such a situation is that a “claim cannot be patentably distinct over anticipatory subject matter.” *Geneva Pharmaceuticals, Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1383 (Fed. Cir. 2003).

We agree with the Examiner that claim 14 of Nykoluk teaches an article that represents a species of claim 27. Appellant argues that claim 14 does not teach a “non-extendable portion configured to be fixedly attached

to the base” (App. Br. 15) and that the handle is “not positioned over the base when the baggage is in an upright position (*id.*). However, this is contradicted by the plain language of claim 14. Claim 14 states that the handle has “non-extending portion of the telescoping member” (Nykoluk, col. 10, ll. 22-23). Additionally, claim 14 requires that the handle is “selectively extended upwardly and forwardly from the pack” (Nykoluk, col. 10, ll. 16-17), which will place the handle in a position not over the base when the base is in an upright position. We therefore find that claim 14 of Nykoluk teaches a species of instant claim 27.

Appellant’s arguments regarding the additional elements taught in claim 14 of Nykoluk are not relevant to the obviousness analysis, since claim 14 of Nykoluk anticipates, and therefore renders obvious, instant claim 27. We note that the same features are relied upon to distinguish claim 39, and that claim 39 is also anticipated by claim 14 of Nykoluk.

We affirm the rejection of claims 27 and 39 under the nonstatutory obviousness type double patenting rejection. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 28-38 and 40-49 as these claims were not argued separately.

B. 35 U.S.C. § 112, second paragraph indefiniteness rejection

The Examiner contends that “the claim is confusing in term of identifying the base being part of the handle or not. On claims 27 and 39, applicant defines the base as part of the baggage and excludes the base being part of the towing member, and on the other claims 34 and 45, applicant defines the base as part of the towing member” (Ans. 7).

Appellant argues that the “independent claims 27 and 39 do not positively recite the ‘base’ while claims 34 and 45 do. The claims are therefore submitted to be properly written, are believed to be clear and definite as they stand, and would be readily understood by those in the art when read in light of the specification” (App. Br. 18).

In view of these conflicting positions, we frame the indefiniteness issue before us as follows:

Are claims 34 and 45 indefinite because it is unclear whether the base is part of the handle or part of the towing member?

Discussion of 35 U.S.C. § 112, second paragraph indefiniteness rejection

The Federal Circuit has noted that “[t]he standard of indefiniteness is somewhat high; a claim is not indefinite merely because its scope is not ascertainable from the face of the claims.” *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1342 (Fed. Cir. 2003). Rather, “[a] claim is indefinite if, when read in light of the specification, it does not reasonably apprise those skilled in the art of the scope of the invention.” *Id.*

We agree with the Appellant that claims 34 and 45 are definite. There is no reason why the towing member cannot have a rigid base that is distinct from the base of the baggage. Claim 27 does not require that the towing

member have a base, only that the towing member is configured to be joined to a piece of baggage with a base (*see* Claim 27). Claims 34 and 45 simply add an additional requirement to the towing member itself, which is that the towing member also have a rigid base and that the rigid base include a pair of wheel wells (*see* Claims 34 and 45). The inclusion of this additional requirement does not render claims 34 and 45 indefinite, but simply further specifies the structure of the towing member.

We reverse the rejection of claims 34 and 45 under 35 U.S.C. § 112, second paragraph.

C. 35 U.S.C. § 102(b) rejection over Gold

Appellant argues that “Gold et al. discloses a child carrier/push stroller that is not a piece of baggage, and the lower fixed supports (20) do not meet the recitation of the non-extendable portion of claim 27 because they are not attached to a base at an interior location” (App. Br. 25). Appellant further contends that Gold doesn’t teach some preamble and body elements “which are submitted to define structure of the claimed components in terms of interrelationships with other recited components and attributes which they possess in the completed assembly. The structure, relationships, and attributes recited in the claims may not be ignored under a proper reading of the claims” (App. Br. 26).

The Examiner “submits that the limitation following ‘configured to be fixedly attached’ is an intended use. The claims so far only recite a non-extendable portion, a curved arm.” (Ans. 7-8). The Examiner further argues that the “recitation ‘configured to be joined’ has not been given patentable weight because the recitation occurs in the preamble” (Ans. 8).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the towing member of Gold satisfy all of the limitations of claim 27?

Findings of Fact

4. Gold teaches that a “[h]andlebar apparatus **25** is mounted to the rear support frame member **12** using handlebar mounting devices **22**” (Gold, col. 3, ll. 8-9).

5. Gold teaches that the “handlebar unit **25** may incorporate an extendable handlebar system thus allowing the height of the push bar **23** to be adjusted” (Gold, col. 3, ll. 17-19).

6. Gold teaches that the “method shown incorporates upper telescoping vertical supports **28** which can slide up and down within the lower fixed supports **20**” (Gold, col. 3, ll. 19-21).

7. Gold discloses that the handlebar unit is curved in figure 4, which is reproduced below.

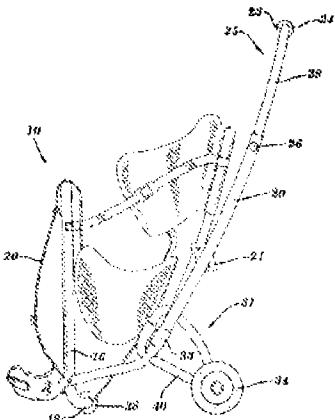


FIG. 4

Figure 4 of Gold shows a child carrier with a curved handle.

Discussion of 35 U.S.C. § 102(b) over Gold

Claim 27

We agree with the Examiner that Gold teaches an article that meets all of the requirements of claim 27. Specifically, Gold teaches a towing member which comprises a handle (FF 4) with an extendible portion (FF 5) and fixed, non-extendible portion (FF 6). Gold discloses that the extendible portion may be curved and retract into the fixed portion (FF 7).

In analyzing the claim language, we give claim phrases their broadest reasonable interpretation. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”). The argued difference for Gold is whether Gold teaches a towing member which is “configured to be fixedly attached to the base at a location interior to the piece of baggage” (Claim 27).

The argued limitation states the purpose or intended use of the towing member but it does not require that the towing member actually be attached to the interior location of a piece of baggage in order to come within the scope of the claim. Thus, while the claim requires that the towing member be capable of attaching to interior locations of baggage, it does not require that such an attachment, or indeed any attachment to baggage, in order to anticipate or infringe the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”).

We interpret claim 27 as directed towards a towing member with a handle, a non-extendable portion and a curved portion which can be telescoped into the non-extendable portion when retracted. The “configured to be fixedly attached to the base at a location interior to the piece of baggage” language (Claim 27) is not a structural element of the towing member of claim 27. Therefore, Gold anticipates claim 27 since Gold teaches all of the structural elements of claim 27 (FF 4-7).

Claims 28 and 39

We are not persuaded by Appellant’s argument for claims 28 and 39 that the handle bar of Gold is “not uniformly curved along a complete length” (App. Br. 26). Appellant relies upon the fact that the handle bar of Gold has two curved support members which have a nearly 90 degree bend to form the handle (*see* Gold, fig. 3; App. Br. 26). However, claim 28 simply states “the arm being uniformly curved” (claim 28) where the “arm” in claim 28 refers to the “curved arm” in claim 27 that is telescoped into the non extendable

portion. Appellant wants to expand the “arm” to include the “handle”, which is listed as a separate physical structure in claim 27, distinct from the “curved arm” (*see* Claim 27). Thus, properly interpreting the “arm” as referring only to the “curved arm” and not also incorporating the “handle”, the “curved arm” of Gold is uniformly curved from the proximal to distal end, where the distal end is where the handle begins (*see* Claim 27) and the proximal end is the end which is attached to the non-extendible portion (FF 7, Gold, fig. 4).

We affirm the rejection of claims 27, 28 and 39 under 35 U.S.C. § 102(b) over Gold. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 29, 31-32, 34, 37, 38, 40-44, and 46-48 as these claims were not argued separately.

D. 35 U.S.C. § 103(a) rejection over Gold and Miyoshi

Appellant argues that “[t]here is no apparent connection between the disclosure of Gold et al. relating to child carrier/stroller with removable wheel unit and the disclosure of Miyoshi relating to a bag with casters that would logically lead to the combination proposed in the Office Action” (App. Br. 30). Appellant also contends that

Miyoshi is submitted to directly contradict and teach away from the invention of claim 27 wherein the handle is positioned forward of the base and not positioned over the base when the arm is in the extended position. Indeed, Miyoshi teaches precisely the opposite, namely the use of curved rods that position the handle at the middle of the bag between the left and right sides of the bag when extended.

(App. Br. 30.)

The Examiner “submits that both Miyoshi and Gold are related to curved telescoping handle. Thus, to provide additional telescoping portions as taught by Miyoshi would have been obvious” (Ans. 8).

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Would it have been obvious to an ordinary practitioner at the time the invention was made to incorporate multiple telescoping regions as taught by Miyoshi into the towing member of Gold?

Findings of Fact

8. Miyoshi discloses that the “extensible rods 55 are rods that can be extended in two or three segments” (Miyoshi, col. 4, ll. 46-47).

Discussion of 35 U.S.C. § 103(a) rejection over Gold and Miyoshi

In *KSR*, the Supreme Court stated that

[t]he principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.

KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1740 (2007).

Applying the *KSR* standard of obviousness to the findings of fact (FF 4-8), we conclude that there the combination of multiple telescoping sections as taught by Miyoshi in the towing member of Gold represents a combination of known elements which yield the predictable result of superior retraction through the use of multiple telescoping sections. Such a

combination is merely a “predictable use of prior art elements according to their established functions.” *KSR Int’l*, 127 S. Ct. at 1740.

We also reject Appellant’s argument that Miyoshi teaches away from the invention because Miyoshi teaches a curved arm which is shown as curved over the baggage (*see, e.g.*, Miyoshi, fig. 6). Like our appellate reviewing court, “[w]e will not read into a reference a teaching away from a process where no such language exists.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006). There is no teaching in Miyoshi which teaches that multiple telescoping members must be oriented in only one direction.

We affirm the rejection of claim 33 under 35 U.S.C. § 103(a) over Gold and Miyoshi.

E. 35 U.S.C. § 102(b) rejection over Raynor

Appellant argues that “Raynor discloses a combination baby stroller and vehicle seat bearing no apparent relation to the towing member configured to joined to a piece of baggage as claim 27 recites when all words of the claims are given effect” (App. Br. 27). Appellant further argues that the “body (20) is clearly not a piece of baggage and the members (35) extend on exterior edges, rather than being configured to be fixedly attached at a location interior to the body (20)” (App. Br. 27).

The Examiner “submits that the limitation following ‘configured to be fixedly attached’ is an intended use. The claimed subject matter is a handle. The recitation of the intended use handle attached to a piece of baggage does not impart any handle over the handles in Raynor” (Ans. 8).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the towing member of Raynor satisfy all of the limitations of claim 27?

Findings of Fact

9. Raynor teaches “a pair of slidable arcuate handle members **36** configured to conform to the curvatures of the tubular members or [sic] sockets **35**” (Raynor, col. 2, ll. 30-32).

10. Raynor teaches that a “pair of parallel arcuate tubular members **35** extend along the tops of the sidewalls **23** from the front wall **22** to a point slightly above and to the rear of back **24**” (Raynor, col. 2, ll. 27-29).

11. Raynor teaches that “when handle members **36** are telescoped inwardly they assume the position shown in dotted lines adjacent the back **50** of a vehicle seat **51** as shown in FIG 1” (Raynor, col. 2, ll. 49-52).

12. Raynor teaches that the telescoping arms are curved (Raynor, fig. 1).

Discussion of 35 U.S.C. § 102(b) over Raynor

We agree with the Examiner that Raynor teaches an article that meets all of the requirements of claim 27. Specifically, Raynor teaches a towing member which comprises a handle (FF 9) with an extendible portion (FF 11) and fixed, non-extendible portion (FF 10). Raynor discloses that the extendible portion may be curved and retract into the fixed portion (FF 11-12).

As discussed above, we give claim phrases their broadest reasonable interpretation. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)

(“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”).

The argued difference for Raynor is whether Raynor teaches a towing member which is “configured to be fixedly attached to the base at a location interior to the piece of baggage” (Claim 27).

The argued limitation states the purpose or intended use of the towing member but it does not require that the towing member actually be attached to the interior location of a piece of baggage in order to come within the scope of the claim. Thus, while the claim requires that the towing member be capable of attaching to interior locations of baggage, it does not require such an attachment, or indeed any attachment to baggage, in order to anticipate or infringe the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”).

We affirm the rejection of claim 27 under 35 U.S.C. § 102(b) over Raynor. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 32 and 37 as these claims were not argued separately.

F. 35 U.S.C. § 102(b) rejection over Miyoshi

Appellant argues that

[i]ndependent claims 27 and 39 each recite that the handle is “positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm is in the extended position.” Miyoshi teaches the use of curved rods that position the handle directly over the middle of the bag between the left and right sides of the bag when the bag is an upright position and when the telescoping rods are extended.

(App. Br. 28.)

The Examiner argues that the claims are “only directed to a handle” (Ans. 9). The Examiner contends that “the limitations with respect to the baggage do not impart any structure over the handle in Miyoshi. The handle in Miyoshi can be configured to be [in] position over the base” (Ans. 9).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does the towing member of Miyoshi satisfy all of the limitations of claim 27?

Findings of Fact

13. Miyoshi teaches that with “the bag mounted with the handle at the middle of the upper face of the bag body, it is necessary to fix extensible rods **25** of the handle **23** to the inside of the bag body **24**” (Miyoshi, col. 2, ll. 26-28).

14. Miyoshi teaches that “the extensible rods are curved so as to be located at the middle of the upper face between the right and left sides of the bag body” (Miyoshi, col. 3, ll. 6-8).

Discussion of 35 U.S.C. § 102(b) over Miyoshi

As discussed above, we give claim phrases their broadest reasonable interpretation. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”).

The claim language at issue in the Miyoshi rejection is the requirement in claim 27 for “the handle being positioned forward of the base and not positioned over the base when the baggage is in upright position and the arm

is in the extended position” (Claim 27). This statement is more than a statement of intended use because it requires that the curvature of the arm be convex on the side of the handle which is “configured to be fixedly attached to the base” (Claim 27).

However, while Miyoshi teaches a handle with curved rods (FF 13-14), the orientation of Miyoshi is for the curvature to be positioned over the base, which is directly opposite of the limitation of claim 27 (*see* Miyoshi, fig. 10).

We are not persuaded by the Examiner’s argument that “the limitations with respect to the baggage do not impart any structure over the handle in Miyoshi” (Ans. 9). The structure of the prior art handle of Miyoshi will not satisfy the curvature requirements of claim 27 unless alterations are made in the mode of attachment of the prior art Miyoshi handle to the baggage, since Miyoshi discloses only one orientation for the handle (*see, e.g.*, Miyoshi, fig. 10). The issue is not whether such alterations might have been obvious, since this is an anticipation rejection. The issue is therefore whether Miyoshi actually teaches a towing member which satisfies the requirements of claim 27. Because the Miyoshi towing member would not attach to a base in a manner necessary to satisfy the curvature requirement, we agree with Appellant that Miyoshi does not teach all of the limitations of claim 27.

We reverse the rejection of claims 27-29, 32-35, 37-40, 43, 44, 46, 48, and 49 under 35 U.S.C. § 102(b) over Miyoshi.

G. 35 U.S.C. § 103(a) rejection over Miyoshi and Godshaw

The Examiner relies on the Miyoshi as discussed above. The Examiner relies on Godshaw to teach “an alternative containing device” (Ans. 6). The Examiner has not identified and we do not find a teaching in Godshaw that

would make up for the deficiency in the Miyoshi discussed above.

Accordingly, we reverse the rejection of claims 36 and 47 under 35 U.S.C. § 103(a) as unpatentable over Miyoshi and Godshaw.

H. 35 U.S.C. § 102(e) rejection over Mao

Appellant argues that the rejection over Mao is overcome by a declaration (App. Br. 19-20). In particular, Appellant argues that the declaration

establishes two alternative evidentiary bases for overcoming the rejection based upon the Mao patent, namely (1) that Applicant actually reduced the invention to practice at a date before the Mao patent was filed in June of 2000 (see paragraph 11F of the declaration discussing a prototype of the invention that was manufactured on or about November of 1999), thereby antedating the Mao reference and removing it from prior art that can be cited against the claims; and (2) that Applicant's invention was subsequently disclosed to Mao and became the basis for Mao's patent application, thereby establishing that Mao's invention was derived from Applicant's earlier work.

(App. Br. 21.)

The Examiner “submits that the 37 CFR 1.132 declaration is not sufficient to over[come] the Mao rejection, since both have the same assignee, TRG, Accessories, LLC” (Ans. 7). The Examiner also argues that “according to the complaint with the US District Court for the Eastern District of Missouri, applicant asserts that the invention of Mao is the same invention as set forth in this application. Thus the application of MPEP § 715, II(B) is entirely applicable” (Ans. 7).

Discussion of 35 U.S.C. § 102(e) over Mao

We begin the analysis of whether the 102(e) rejection may be overcome by a 1.132 declaration by determining under what ground Appellant relies. Appellant's declaration states that “[t]o the extent that the '706 patent describes subject matter that relates to the Claimed Invention of the '033 application, Chen Shou Mao derived and copied such subject matter from me” (Nykoluk Dec. ¶ 5).

“An applicant may also overcome a reference by showing that the relevant disclosure is a description of the applicant's own work” *In re Costello* 717 F.2d 1346, 1349 (Fed. Cir. 1983). The MPEP is consistent with the Federal Circuit, noting that “an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant” MPEP § 716.10.

In the instant case, the Nykoluk Declaration unambiguously states that Mao derived the invention from Nykoluk and provides factual evidence to support this position (see Nykoluk Dec. ¶ 5-22). The Examiner has provided no evidence which rebuts that provided in the Nykoluk Declaration. We therefore find that Nykoluk has demonstrated derivation as required by the MPEP and *Costello*.

We are not persuaded by the Examiner's reliance on MPEP § 715 II(B), since that section of the MPEP relates to 1.131 declarations designed to antedate a reference, not 1.132 declarations relying upon derivation. Additionally, we note that MPEP § 715 II(B) refers to the “same patentable invention”, and this standard is the same as that for statutory double patenting. Claim 1 of Mao clearly incorporates subject matter which differs from the

Appeal 2008-1778
Application 10/875,394

instant claims, including “luggage”, “shoulder straps”, and a “spherical slot”, none of which are recited in the instant claim 27. Thus, claim 1 of Mao is not drawn to the “same” patentable invention.

We reverse the rejection of claims 27-49 under 35 U.S.C. § 102(b) over Mao.

CONCLUSION

In summary, we affirm the rejection of claims 27 and 39 under the nonstatutory obviousness type double patenting rejection. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 28-38 and 40-49 as these claims were not argued separately.

We reverse the rejection of claims 34 and 45 under 35 U.S.C. § 112, second paragraph.

We affirm the rejection of claims 27, 28 and 39 under 35 U.S.C. § 102(b) over Gold. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 29, 31-32, 34, 37, 38, 40-44, and 46-48 as these claims were not argued separately.

We affirm the rejection of claim 33 under 35 U.S.C. § 103(a) over Gold and Miyoshi.

We affirm the rejection of claim 27 under 35 U.S.C. § 102(b) over Raynor. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 32 and 37 as these claims were not argued separately.

We reverse the rejection of claims 27-29, 32-35, 37-40, 43, 44, 46, 48, and 49 under 35 U.S.C. § 102(b) over Miyoshi. We also reverse the rejection of claims 36 and 47 under 35 U.S.C. § 103(a) as unpatentable over Miyoshi and Godshaw.

Appeal 2008-1778
Application 10/875,394

We reverse the rejection of claims 27-49 under 35 U.S.C. § 102(b) over Mao.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

cdc

Patrick W. Rasche
Armstrong Teasdale LLP
Suite 2600
One Metropolitan Square
St. Louis MO 63102